

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	Daniel J. Fisher	Examiner:	Bryan R. Muller
Serial No.:	10/821,071	Group Art Unit:	3723
Filed:	April 8, 2004	Docket No.:	M120.253.101 / 59554US002
Due Date:	April 1, 2008		
Title:	ATTACHMENT SYSTEM FOR A SANDING TOOL		

REPLY BRIEF TO SUPPLEMENTAL EXAMINER'S ANSWER
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Mail Stop Appeal Brief – Patents
Commissioner for Patents
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Reply Brief Under 37 C.F.R. §41.41(b)

This Reply Brief is responsive to the Supplemental Examiner's Answer mailed February 1, 2008, and supports the Notice of Appeal filed on April 17, 2007 appealing from the final rejection dated January 17, 2007 of claims 1-9, 14, 15, 28-34, 37, 38, 41, and 42 of the above-identified application. Twenty-two claims remain for consideration.

The U.S. Patent and Trademark Office is hereby authorized to charge required fees or credits due to Deposit Account No. 50-0471 at any time during the pendency of this application.

ARGUMENT

All arguments presented in Appellant's Appeal Brief and Reply Brief are incorporated by reference herein. Further, Appellant responds to the Supplemental Examiner's Answer as follows.

I. FIRST GROUNDS OF REJECTION

The Supplemental Examiner's Answer appeared to assert two theories under which independent claim 28, and claims 29-32 that depend thereon, were rejected. First, that Kleemeier anticipates claims 28-32, and second that if claim 28 is interpreted as asserted by Appellant, then claim 28 is effectively withdrawn as being directed to a non-elected species. With the Supplemental Examiner's Answer, it appears the second theory has now been retracted. In the interest of completeness, however, Appellant responds to the two theories as follows:

Claim 28 recites a conversion pad having first and second major surfaces. The second major surface includes an attachment surface including attachment material, and a non-attachment surface along an edge region of the second major surface. With this in mind, claim 28 further recites that the attachment surface and the non-attachment surface each terminate, and are co-planar, opposite the first major surface. By this language, then, the surfaces to which the co-planar relationship must be established is relative to the spatial location at which the attachment surface and the non-attachment surface each terminate. Thus, the statement in the Supplemental Examiner's Answer that "the claim limitations of claim 28 *do not* define the attachment layer as only being the terminal ends of the fibers," is irrelevant to the co-planar limitation. In other words, regardless of whether claim 28 does or does not require the attachment layer to be only the terminal ends of fibers, what claim 28 does recite is that the claimed co-planar relationship is relative to the termination point of the attachment surface and the termination point of the non-attachment surface. With this understanding in mind, the purported attachment material 16, 17 of Kleemeier clearly terminates at the fiber heads 16a, 17a. The fibers 16, 17 are of differing lengths, such that a planar surface at the heads 16a, 17a is not

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defined, let alone a surface that is co-planar with the purported non-attachment surface 14. Thus, claim 28, and claims 29-32 depending thereon, are not anticipated by Kleemeier.

With respect to the apparent second theory under which the Examiner at least previously asserted that the above arguments render claims 28-32 as being directed toward a non-elected species, the Supplemental Examiner's Answer now states that "the arguments referring to the election requirement appear to be irrelevant to the appealed rejection of the claims." To the extent this statement represents a retraction of the Examiner's previous positions with respect to claims 28-32 and the Species Election Requirement of October 4, 2005, Appellant agrees. However, to the extent the Examiner intends to maintain this second theory, Appellant respectfully disagrees. Appellant has not argued the propriety of the Species Election Requirement. To the contrary, Appellant rightfully presumed that the Species Election Requirement was complete, and that the subsequent Election was accepted by the Examiner. As previously argued, nothing in the Species Election Requirement restricted examination to one or more of the figures. While the Examiner may now wish to have worded the Species Election Requirement in this way, it is improper to do so after-the-fact. In sum, the Species Election Requirement, and Appellant's corresponding Election, was in no way limited to one or more figures of the application. Thus, claim 28 is properly construed as described above and is properly currently pending for examination and review with this Appeal.

II. SECOND GROUNDS OF REJECTION

In the Supplemental Examiner's Answer, the Examiner asserts that the "conversion pad" set forth in claim 1 is merely an intended use. Appellant respectfully disagrees, and asserts that the "conversion pad" of claim 1 entails structural limitations not taught or reasonably made obvious by Kleemeier. For example, Kleemeier fails to disclose a pad that is removably attached to a back-up pad to change the attachment system of the back-up pad as otherwise required by the claim 1. To the contrary, Kleemeier relates to a device for gripping non-woven fibrous discs, and describes various types of holders for such discs, all of which use projecting fibers to grip the non-woven disc. The driving layer 15 of Kleemeier is an improved version of such a holder

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with projecting fibers, but does not change the attachment system (e.g., the projecting fibers). Accordingly, Kleemeier fails to disclose a conversion pad as claimed, and because Kleemeier does not contemplate accommodating abrasive discs with different attachment systems, Kleemeier does not reasonably make obvious the claimed conversion pad.

In addition, the Supplemental Examiner's Answer asserts that the "forming an attachment ... that is weaker than the attachment between the attachment region and the associated mating surface" limitation of claim 1 is met by the absence of attachment material associated with the outer region of the resin layer 14 of Kleemeier. In this regard, the Supplemental Examiner's Answer references dependent claim 9 as reciting "the fastening elements are bent to prevent attachment," and then concludes from this limitation that "removing of the attachment material will clearly provide a complete absence of material and other alteration that 'prevents attachment' will clearly fail to provide any attachment at all." Appellant respectfully submits that this interpretation is without support. The language of claim 9 is consistent with the language of claim 1 in which the non-attachment region must be capable of forming an attachment with the abrasive article, but at a reduced or weaker level. While complete attachment is prevented, nothing in claim 9 dictates that no attachment material will be present or that a weak level of attachment will occur. The Examiner's reference to claim 13 as further supporting incorrect interpretation of claim 1 is moot as claim 13 has been withdrawn. Thus, claim 1 requires a non-attachment region configured to be capable of forming an attachment with the abrasive article, but at a reduced or weaker level. Because the "empty" outer region associated with the resin layer 14 of Kleemeier is entirely void of any possible attachment to the abrasive article 20, independent claim 1, as well as dependent claims 2-7, 14, and 15, are allowable over Kleemeier in view of Edinger.

III. THIRD-SIXTH GROUNDS OF REJECTION

Appellant reasserts all previous arguments traversing the remaining grounds of rejection.

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CONCLUSION

For all of the reasons presented, removal of the rejections is requested.

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Respectfully submitted,

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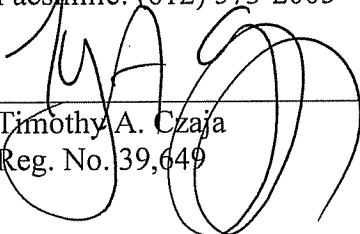
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